

ESTTA Tracking number: **ESTTA423783**

Filing date: **08/07/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	BREVO, LLC
Granted to Date of previous extension	08/07/2011
Address	1326 S.E. 17th Street, Suite 265 Fort Lauderdale, FL 33316 UNITED STATES
Attorney information	Thomas P. Philbrick ALLMARK TRADEMARK 2089 Avy Ave. Menlo Park, CA 94025 UNITED STATES allmarktrademark@gmail.com, tom@allmarktrademark.com Phone:(925)648-4839

Applicant Information

Application No	85115591	Publication date	02/08/2011
Opposition Filing Date	08/07/2011	Opposition Period Ends	08/07/2011
Applicant	MZB Imagination LLC 4th floor 29-76 Northern Blvd Long Island City, NY 11101 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Paper clips
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Prior common law use in commerce of a confusingly similar mark

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SILLY CLIPZ (U.S. Serial Number 85391291 filed on August 5, 2011)		

	Application data not yet uploaded to USPTO website.
Goods/Services	Paper clips, in class 16. Hair clips; Hair accessories, in class 26. Attachable, wearable, toy clips, in class 28. Online retail store services featuring toys, office supplies, hair clips and hair accessories, in class 35.

Attachments	SILLY CLIPZ opposition against 85115591 owner MZB 08072011.pdf (8 pages)(135285 bytes) ellen exhibit A sized for filing.pdf (1 page)(122182 bytes) 85115591 SILLY CLIPZ app file exhibit owned by MZB.pdf (6 pages)(486885 bytes) Certificate of Service SILLY CLIPZ opp v MZB.pdf (1 page)(14125 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Thomas P. Philbrick/
Name	Thomas P. Philbrick
Date	08/07/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application serial no. 85115591

Filed on August 25, 2010

BREVO, LLC

Opposer,

v.

MZB IMAGINATION LLC

Applicant.

)
)
)
) Opposition No. _____
)
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)
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Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

BREVO, LLC, a limited liability company legally organized under the laws of Florida, with a principal place of business of 1326 S.E. 17th Street, Suite 265, Fort Lauderdale, FL 33316, (hereinafter “Opposer”), having filed timely extensions of time to oppose, hereby believes that it is being damaged and will continue to be damaged by the application for the mark SILLY CLIPZ (standard character mark) in International Class 16 shown in U.S. serial no. 85115591, and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. MZB IMAGINATION LLC, a limited liability company of New York (hereinafter “Applicant”) is the current listed owner of record of the application for the mark SILLY CLIPZ

(standard character mark) as identified in U.S. Serial. No. 85115591 (“Applicant’s application”) that is seeking registration in connection with “Paper clips,” in International Class 16. Applicant’s last known address of record as indicated on the USPTO’s TARR database is 4th Floor 29-76 Northern Blvd., Long Island City, NY 11101.

2. Opposer has used the mark SILLY CLIPZ in interstate commerce since at least as early as August 15, 2010 (well before the application filing date of Applicant’s “intent to use” serial number 85115591) in conjunction with a variety of goods and services including, “Hair accessories and hair clips,” in International Class 26 and “Paper clips,” in International Class 16. Opposer is the owner of U.S. Serial No. 85391291 (Opposer’s mark) for the mark SILLY CLIPZ filed on a Section 1(a) basis, on August 5, 2011, used in connection with “Hair accessories and hair clips,” in International Class 26, “Paper clips,” in International Class 16, “Attachable, wearable, toy clips,” in International Class 28, and “Online retail store services featuring toys, office supplies, hair clips and hair accessories,” in International Class 35. Based on Opposer’s substantiated prior interstate use of its SILLY CLIPZ mark in commerce and resulting goodwill, Opposer believes that it is being and will be damaged by the registration of Serial No. 85115591 as it creates a confusingly similar overall commercial impression to Opposer’s mark (in fact identical) and is used in connection with identical goods in International Class 16 that are also related to and complimentary to Opposer’s class 26, 28 and 35 goods/services. In addition, Opposer has priority of use over Applicant based on its interstate usage in commerce prior to Applicant’s adoption (and alleged *bona fide* intention to use) of identical and/or confusingly similar SILLY CLIPZ related marks.

3. Prior to filing its application serial number 85391291, Opposer became aware of Applicant’s Application serial number 85115591 via a search of the U.S. trademark register. On

the basis of similarities in appearance (identical) and fields of usage, Opposer has a reasonable belief and is in fact certain that Applicant's prior filed application will be cited as a Section 2(d) "likelihood of confusion" conflict refusal against Opposer's SILLY CLIPZ application upon its eventual examination by the USPTO. Opposer therefore has standing to file this opposition as the registration of its SILLY CLIPZ mark in Classes 16, 26, 28 and 35 (as identified in Serial Number 85391291) will be refused (causing irreparable damage and injury to Opposer) if serial number 85115591 is not successfully opposed and ultimately refused registration.

4. If Applicant's application is not successfully opposed, Applicant will own the *prima facie* exclusive right to use the SILLY CLIPZ mark in International Class 16 in connection with goods that the Examining Attorney will certainly deem "confusingly similar" to Opposer's SILLY CLIPZ goods as they are identical. Such a registration would be a source of damage and injury to Opposer as it would prevent the USPTO from issuing a registration to Opposer based on its pending application serial number 85391291.

5. In view of the substantial similarity (in fact identical appearances) between the respective marks (serial numbers 85115591 and 85391291), Opposer's prior use in commerce, and the commercial relationship between the goods/services at issue, registration of the SILLY CLIPZ mark herein opposed to Applicant in class 16, must be refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The mark depicted in Applicant's application so resembles a mark previously used in the United States by Opposer and not abandoned, as to be likely, when used on or in connection with the goods or services of Applicant, to cause confusion, or to cause mistake, or to deceive. Opposer has continued to exploit, use and further develop the SILLY CLIPZ mark on an ongoing basis by developing and using it on an e-commerce website prior to the filing date of Applicant's application, by being featured in

newspaper articles, by receiving multiple purchase orders from Fortune 100® retailers for national distribution, and by appearing on the Ellen DeGeneres television show to showcase the SILLY CLIPZ goods to the consuming public, among other efforts to further promote and develop the use of the mark. (See Exhibit A attached illustrating the appearance of the son of the Opposer's president on the Ellen DeGeneres show discussing the SILLY CLIPZ mark.)

6. On August 25, 2010, Applicant submitted a declaration pursuant 18 U.S.C. Section 1001 with its application signed by its "business affairs manager," Monica Titera, to the USPTO for application Serial number 85115591 in which it stated that...

"The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; **to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.**" This statement left Applicant declaring that to the best of the declarant's knowledge and belief, there were no other prior users of a similar/identical mark.

[Copy of Applicant's application serial number 85115591 including the signed declaration of its "business affairs manager" is attached as "**Exhibit B**"]

7. Based on information readily obtainable to the general public via internet searches, Opposer alleges on information and belief that Applicant's application, which indicates in its signed declaration that it did not know of the Opposer's prior use in commerce of the SILLY CLIPZ mark was submitted on a knowingly false basis (with the specific intent to deceive the USPTO) as Applicant must have known of Opposer's prior use in commerce of SILLY CLIPZ prior to the submission of the subject intent to use application on August 25, 2010.

8. On information and belief, Opposer alleges the following specific statements of fact (lettered alphabetically) upon which the belief of Applicant's fraudulently submitted application is reasonably based. On information and belief, the following publicly available facts that form the basis for Opposer's belief, were known by Applicant prior to the filing of Applicant's application, which establish the fraudulent nature of the application submission. Opposer alleges that the confirmation of Applicant's knowledge of these facts prior to its application filing is likely to be obtained from it after a reasonable opportunity for discovery and/or investigation.

a. The domain name www.sillyclipz.com was registered on June 19, 2010 and it is standard procedure for a business to search domain name availability prior to filing a trademark that is identical to the domain name. Said domain name registration was well over two months prior to the filing of Applicant's application.

b. On July 28, 2010, nearly one month prior to the filing of Applicant's application, Opposer launched its e-commerce website using the SILLY CLIPZ mark at www.sillyclipz.com and

Opposer's first internet sales of its hair clips, hair accessories, paper clips and attachable, wearable toy clips took place on this day via its website.

c. On August 16, 2010, over one week prior to the filing of Applicant's application, Opposer purchased the domain name www.sillyclips.com to defend its trademark against possible cybersquatters that might attempt to misdirect traffic away from www.sillyclipz.com.

On information and belief, Opposer alleges that the above outlined facts (listed as paragraphs "a-c") were known by Applicant prior to the filing of Applicant's application. Opposer alleges that the confirmation of Applicant's knowledge of the above referenced facts prior to application filing will quickly be obtained after a reasonable opportunity for discovery and/or investigation.

9. Based on the above referenced statement of facts in Paragraph Number 8 which is incorporated herein by reference, Opposer alleges that Applicant procured approval for publication for Serial No. 85115591 by false means and/or by knowingly, willfully and intentionally making false and/or fraudulent declarations or representations to the USPTO (with the specific intent to deceive the USPTO) including, falsely alleging in the original application filed on August 25, 2010 that Applicant was not aware of (inter alia) any **"other person, firm, corporation, or association [that] has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."** ("**[that]**" added for clarity) On information and belief, Opposer alleges that the willfully fraudulent declaration submitted with Applicant's application was filed with the specific intent to obtain something that Applicant would not otherwise have been entitled to, namely, a federal trademark registration for the mark SILLY CLIPZ that it knew was

already being used in interstate commerce by Opposer for identical and/or confusingly similar goods/services.

10. Based on the statement of facts in Paragraph 8 of the Notice of Opposition (herein incorporated by reference), Opposer alleges on information and belief that Applicant knew at the time it filed its Section 1(b) "intent to use" application serial number 85115591 that Opposer was already using the identical SILLY CLIPZ mark in commerce. On information and belief, by definition, the fraudulent declaration submitted with Applicant's application evidences a specific intent on the part of Applicant to fraudulently deceive the USPTO into granting it a registration that it would not otherwise have been entitled to under USPTO rules and procedures.


11. For the foregoing reasons, Applicant is not entitled to the registration of Serial No. 85115591 for the mark SILLY CLIPZ in International Class 16 as Opposer has priority of use in commerce for an identical mark for identical/related goods/services. As a separate ground for refusal of Applicant's application, on information and belief, Opposer alleges that it was filed and prosecuted to publication in the Official Gazette with the specific and willful intent to commit fraud on the USPTO by asserting in the application declaration that Applicant was not aware of 3rd party use of a confusingly similar mark, namely, that of the Opposer.

WHEREFORE, Petitioner prays that this opposition be sustained in its favor and that Serial. No. 85115591 for the mark SILLY CLIPZ be refused in its entirety.

DATED this 7th day of August, 2011.

Respectfully submitted,

BREVO, LLC

By: 

Thomas P. Philbrick, Esq.

John E. Russell, Esq.

Attorneys for Opposer

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Menlo Park, CA 94025

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NOW PLAYING: Ellen Meets the Silly Clipz Inventor

RATING ★★☆☆



PLAYLIST

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Ellen in a Minute - 08/05/11
An hour of Ellen fun wrapped up into a couple minutes!

▶ PLAY Min 1:42



Ellen's Monologue - 08/05/11
Twits & Ask

▶ PLAY Min 5:25



James Franco's Dressing Room Relaxation!
Before James Franco came on the show to chat with Ellen, he received a little relaxation therapy from his friend - with rocks! The funny duo

▶ PLAY Min 0:44



The Adorable Darius & Demetrice Sing!
Ellen welcomed back the cute twin boys, Darius & Demetrice. They cheated with Ellen before singing for everyone.

▶ PLAY Min 3:59

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ellen

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Trademark/Service Mark Application, Principal Register

Serial Number: 85115591

Filing Date: 08/25/2010

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85115591
MARK INFORMATION	
*MARK	SILLY CLIPZ
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	SILLY CLIPZ
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	MZB Imagination LLC
INTERNAL ADDRESS	4th floor
*STREET	29-76 Northern Blvd
*CITY	Long Island City
*STATE (Required for U.S. applicants)	New York
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	11101
PHONE	718-472-7557
EMAIL ADDRESS	mtitera@mzb.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
LEGAL ENTITY INFORMATION	
TYPE	corporation

EXHIBIT B

STATE/COUNTRY OF INCORPORATION	New York
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	016
*IDENTIFICATION	Paper clips
FILING BASIS	SECTION 1(b)
CORRESPONDENCE INFORMATION	
NAME	MZB Imagination LLC
DOCKET/REFERENCE NUMBER	Silly Clips
FIRM NAME	MZB Imagination LLC
INTERNAL ADDRESS	4th floor
STREET	29-76 Northern Blvd
CITY	Long Island City
STATE	New York
COUNTRY	United States
ZIP/POSTAL CODE	11101
PHONE	718-472-7557
EMAIL ADDRESS	mtitera@mzb.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/MONICA TITERA/
SIGNATORY'S NAME	MONICA TITERA
SIGNATORY'S POSITION	BUSINESS AFFAIRS MANAGER
DATE SIGNED	08/25/2010

Trademark/Service Mark Application, Principal Register

Serial Number: 85115591

Filing Date: 08/25/2010

To the Commissioner for Trademarks:

MARK: SILLY CLIPZ (Standard Characters, see [mark](#))

The literal element of the mark consists of SILLY CLIPZ.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, MZB Imagination LLC, a corporation of New York, having an address of
4th floor,
29-76 Northern Blvd
Long Island City, New York 11101
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 016: Paper clips

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Correspondence Information:

MZB Imagination LLC
MZB Imagination LLC
4th floor
29-76 Northern Blvd
Long Island City, New York 11101
718-472-7557(phone)
mtitera@mzb.com (authorized)

The docket/reference number is Silly Clips.

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to

EXHIBIT B

be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /MONICA TITERA/ Date Signed: 08/25/2010

Signatory's Name: MONICA TITERA

Signatory's Position: BUSINESS AFFAIRS MANAGER

RAM Sale Number: 1713

RAM Accounting Date: 08/26/2010

Serial Number: 85115591

Internet Transmission Date: Wed Aug 25 15:24:02 EDT 2010

TEAS Stamp: USPTO/BAS-12.182.82.2-201008251524029980

56-85115591-470e9972b989434a3e8baae813ca

e54a64-CC-1713-20100825151359469269

SILLY CLIPZ


Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

MZB IMAGINATION LLC

2976 Northern Blvd., 4th Floor

Long Island City, NY 11101

A handwritten signature in black ink, appearing to read "Thomas B. O'Connell", written over a horizontal line.

Signature of Attorney for Opposer

Dated: 08/07/2011